

The opinion in support of the decision being entered today was **not** written for publication and is **not** precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

MAR 31 2003

Ex parte JOHN C. NARDI

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Appeal No. 2002-1116
Application No. 09/213,544

HEARD: February 11, 2003

Before WALTZ, PAWLIKOWSKI and MOORE, Administrative Patent
Judges.

PAWLIKOWSKI, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-13 and 15-21. Claim 14 has been cancelled.

Claim 1 is representative of the subject matter on appeal, and is set forth below:

1. An electrochemical cell comprising a positive electrode having an active material and an electrically conductive carbon material including expanded graphite particles having a kerosene absorption value in the range of 2.2 to 3.5 ml/g.

On page 5 of the brief, appellant indicates that the claims stand or fall together, and we therefore consider claim 1 in this appeal. 37 CFR § 1.192(c)(7)(2000).

The examiner relies upon the following reference as evidence of unpatentability:

Mototani et al. (Mototani) 5,482,798 Jan. 09, 1996

Claims 1-13 and 15-21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Mototani.¹

OPINION

For the reasons set forth in the answer and below, we affirm the rejection.

On page 3 of the answer, the examiner finds that Mototani discloses alkaline manganese batteries containing manganese dioxide and expanded graphite, and refers to column 3, lines 40-52 of Mototani. The examiner recognizes that Mototani does not disclose the kerosene absorption values of the disclosed expanded graphite.

In the paragraph bridging pages 3-4 of the answer, the examiner states that Mototani teaches that expanded graphites may be formed from a variety of graphitic starting materials, including artificial graphite, naturally occurring graphite, and flaky graphite, and the examiner refers to column 5, line 24 through column 6, line 3 of Mototani.

We agree with the examiner's findings as described above.

We also refer to example 1 found in column 3 of Mototani wherein the manner in which the battery is prepared is set

¹ We do not include claim 14 in this rejection because claim 14 has been canceled. See Paper No. 8 (the amendment filed on October 19, 2000).

forth. Specifically, example 1 indicates that the carbon material used is made from conventional artificial graphite particles or expanded graphite particles which have been prepared by introducing sulfuric acid "into between interlayers of the artificial graphite used as starting material and heating rapidly the graphite at a temperature of from 800° to 1000°C, to expand greatly spaces between the interlayers of the graphite".

We also observe that page 8 of appellant's specification beginning at line 8, indicates that the expanded graphite additive preferably includes a natural graphite. This graphite is soaked in sulfuric acid and nitric acid until each of the graphite layers has been acid soaked therein. Once the graphite layers are acid soaked by vacuum impregnation, the graphite is ready for heat treatment at a temperature of approximately 1000°C, and within a range of from 850°C to 1100°C.

As noted on page 3 of the answer, the examiner states that because the process for forming expanded graphite as disclosed by appellant (as described in the previous paragraph) is similar to the process disclosed by Mototani, the materials produced would also be similar. We must agree for the following reasons.

We refer to the case of In re Best, 562 F.2d 1252, 1255, 195 USPQ2d 430, 433 (CCPA 1970). In this case, the court sets forth the following:

[I]t is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. Additionally, where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not

possess the characteristic relied on. [58 CCPA at 1031, 439 F.2d at 212-13, 169 USPQ at 229.] This burden was involved in In re Ludtke, 58 CCPA 1159, 441 F.2d 660, 169 USPQ 563 (1971), and is applicable to product and process claims reasonably considered as possessing the allegedly inherent characteristics.

Hence, it is applicant's burden to prove that the subject matter shown to be in the prior art does not possess the characteristics relied on for patentability. However, we determine that appellant has not met this burden for the following reasons.

On page 9 of the brief, appellant indicates that he has attempted to manufacture expanded graphite particles according to the teachings described in Mototani, but submits that Mototani does not describe, in sufficient detail, how to make the expanded graphite "so as to enable one skilled in the art to make samples with a definite known kerosene absorption". This is also indicated on page 2 of the Declaration of Paper No. 9. Hence, the Declaration of Paper No. 9 sets forth examples of several commercially available expanded graphites with their corresponding kerosene absorption values. However, this Declaration does not set forth an example representative of the expanded graphites of Mototani.

From our perspective, the disclosure of Mototani is presumed to be enabling because Mototani, a U.S. Patent, enjoys a statutory presumption of validity, 35 U.S.C. § 282, and enablement is a prerequisite to validity, 35 U.S.C. § 112, first paragraph. Compare In re Spence, 261 F.2d 244, 246, 120 USPQ 82, 83 (CCPA 1958); see also In re Vaeck, 947 F.2d 488, 496 n.23, 20 USPQ2d 1438, 1444-45 n.23 (Fed. Cir. 1991) ("The first paragraph of 35 U.S.C. 112 requires nothing more than objective enablement. In re Marzocchi, 439 F.2d 200, 223, 169 USPQ 367,

369 (CCPA 1971). How such a teaching is set forth, either by use of illustrative examples or by broad terminology, is irrelevant."). This presumption has not been rebutted by any objective evidence of record. In re Sasse, 629 F.2d 675, 679, 207 USPQ 107, 111 (CCPA 1980); Spence, 261 F.2d at 246, 120 USPQ at 83. For example, on this record, the appellants have not presented any clear and convincing evidence that one of ordinary skill in the art would not have been able to make the expanded graphite material of Mototani from the information provided in Mototani, and the knowledge in the art at the time of the invention, without undue experimentation. Compare Vaeck, 947 F.2d at 495, 20 USPQ2d at 1444.

Because appellant has not met the aforementioned burden, we are unconvinced that a representative example of Mototani cannot be reproduced.


Thus, having considered all of the evidence and arguments advanced by the examiner and appellants, we determine that the evidence of obviousness, on balance, outweighs the evidence of nonobviousness. Accordingly, we affirm the examiner's decision rejecting all of the appealed claims under 35 U.S.C. § 103.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

THOMAS A. WALTZ)
Administrative Patent Judge)

BEVERLY A. PAWLIKOWSKI
Administrative Patent Judge


JAMES T. MOORE
Administrative Patent Judge

BAP/sld

Appeal No. 2002-111
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